

REMARKS

I. DECEMBER 3, 2003 AND NOVEMBER 3, 2004 OFFICE ACTIONS

Claims 371-483 are pending in this application.¹ The currently pending claim rejections were set forth in a December 3, 2003 Office Action and a November 3, 2004 Final Office Action. In particular, claims 371-483 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,070,150 to Remington et al. ("the Remington patent") in view of Electronic Funds Transfer Project, Final Report, Washington State, October 1994 ("the Washington State reference").

On June 2, 2004, Applicant responded to the December 5, 2003 Office Action, and on May 3, 2005, Applicant responded to the September 29, 2004 Office Action. Applicant argued that the supplemental Polk declaration and accompanying exhibits, in combination with the declarations and exhibits filed with the June 2, 2004 Reply to Office Action, establish conception of the subject matter of claims 371-483 prior to the filing date of the Remington patent and reasonable diligence from a date just prior to the filing date of the Remington patent through the date of constructive reduction to practice of the present invention. Therefore, the Remington patent is not a prior art reference.

Subsequent to the filing of the May 3, 2005 Reply, there have been developments in the Patent Office regarding Applicant's claims that Remington is not a

¹ In the December 3, 2003 Office Action and the November 3, 2004 Final Office Action, the Examiner listed the pending claims as claims 371-481. Applicant notes that claims 371-483 are actually pending and views these statements as mere oversights by the Examiner.

prior art reference for this family of applications. Indeed, in the reexamination proceedings of U.S. Patent No. 6,119,107 ("the '107 patent," i.e., the grandparent of this application) and U.S. Patent No. 5,946,669 ("the '669 patent," i.e., the greatgrandparent of this application), as described in detail below, the Patent Office has recognized that the patent owner (and Applicant here) had successfully proven that the Remington patent is not prior art to the claimed inventions by showing that conception of the claimed inventions occurred prior to October 18, 1996, the filing date of the Remington patent, and showing that reasonable diligence was exercised by the inventor from a date prior to October 18, 1996 through September 30, 1997, the filing date of first patent application on the invention. Because the Remington patent is not available as prior art to this family of applications, it can neither anticipate nor render obvious the presently-pending claims.

II. NOVEMBER 16, 2005 OFFICE ACTION

On November 16, 2005, the Examiner issued an action entitled "Response to Applicant's Amendment."² As the Examiner explained in a telephone call with Applicant's representative on November 10, 2005, this non-final action was issued so that Applicant could submit evidence and amendments from the reexamination proceedings of the '107 patent and the '669 patent. In those reexaminations, Applicant

² The November 16, 2005 action states that the amendment filed on May 3, 2005 was not fully responsive because "the Applicant's reply does not comply with 37 C.F.R. § 1.121 regarding claim listing." November 16, 2005 Office Action at 2. Because the Reply to Office Action filed on May 3, 2005 did not contain a change to any claim, a listing of claims under 37 C.F.R. § 1.121 was not required. Applicant understands that the November 16, 2005 action was a mere formality used by the Examiner in order to issue a non-final Office Action to which Applicant could respond with additional evidence.

successfully overcame rejections based on the same references cited against the claims pending in the present application based on the evidence and amendments submitted herewith.

III. SWEARING BEHIND THE REMINGTON PATENT

In the reexamination proceedings, Applicant successfully demonstrated that the Remington patent is not prior art to the patent claims by showing that conception of the claimed inventions occurred prior to October 18, 1996, the filing date of the Remington patent. In addition, Applicant successfully proved that reasonable diligence was exercised by the inventor and the attorneys preparing the first patent application on the invention (i.e., U.S. Patent Application No. 08/941,187, the greatgrandparent of the present application) from a date prior to October 18, 1996 through September 30, 1997, the filing date of U.S. patent application No. 08/941,187.

When the Examiner determined that the evidence submitted in the reexamination proceedings sufficiently established that the Remington patent is not available as prior art, he requested that Applicant file the same evidence in the present application. The Examiner agreed that this new evidence, together with the evidence already of record in the present application, would remove the Remington patent as prior art to the claims pending in the present application.

What follows is a summary of the evidence submitted in the reexamination proceedings of the '107 patent and the '669 patent (i.e., the grandparent and greatgrandparent of the present application) together with an indication of whether the evidence is already of record in the present application or submitted herewith as requested by the Examiner.

To demonstrate that the Remington patent is not prior art in the reexamination proceedings, Applicant submitted three declarations, including:

- (1) a Declaration under 37 C.F.R. § 1.131 executed by Mr. John Polk, the named inventor of the claimed subject matter, including Exhibits 1-68 ("the initial Polk declaration");
- (2) a Declaration under 37 C.F.R. § 1.131, executed by Mr. Richard Vesper; and
- (3) a Declaration under 37 C.F.R. § 1.131, executed by Mr. Lionel M. Lavenue.

These declarations were previously submitted in the present application with the June 2, 2004, Reply to Office Action.

In response to these declarations and exhibits, the Examiner in the reexamination proceedings issued an Office Action on August 1, 2005, in which he stated "[t]he Declaration filed on 11 July 2005 under 37 C.F.R. 1.131 has been considered but is ineffective to overcome the Remington et al. (U.S. Patent 6,070,150) reference."³ (Reexamination Control No. 90/006,728, 8/1/05 Office Action, pp. 2-4). In particular, the Examiner raised six specific questions regarding the evidence submitted to show that the Remington patent is not prior art to the claimed inventions. A copy of the August 1, 2005 Office Action in the reexamination case is attached as Exhibit A.

In response to these allegations, and as further evidence of the conception of the claimed invention and the diligence that was exercised, Applicant submitted a Response to Final Office Action in the reexamination proceedings on September 29, 2005, attached as Exhibit B. The Response included a Supplemental Declaration under

³ Although three declarations were filed, Applicant understands the Examiner's reference to "the Declaration" as a reference to the initial Polk declaration.

37 C.F.R. § 1.131, executed by Mr. John Polk ("the Polk supplemental declaration"), the named inventor of the claimed subject matter. The Polk supplemental declaration referred to exhibits 1-68, which were filed with the original Polk declaration, and included exhibits 69-72 (included in the attached Exhibit B).

After consideration of this additional evidence, the reexamination Examiner found that Applicant had successfully proved that the Remington patent is not prior art to the claimed inventions by showing that conception of the claimed inventions occurred prior to October 18, 1996, the filing date of the Remington patent, and showing that reasonable diligence was exercised by the inventor from a date prior to October 18, 1996 through September 30, 1997, the filing date of first patent application on the invention. A copy of the Office Action issued in the reexamination proceedings on March 23, 2005, in which all of the rejections based on the Remington patent were withdrawn, is attached as Exhibit C.

Because the Remington patent is not available as prior art, it can neither anticipate nor render obvious the presently-pending claims. Accordingly, Applicant requests the withdrawal of the rejections of all of pending claims 371-483 because all of the rejections rely upon the Remington patent as prior art.

IV. AMENDMENTS OVER THE WASHINGTON STATE REFERENCE

Claims 371-483 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Remington patent in view of the Washington State reference. In particular, the Examiner stated that the "Washington State reference teaches that the use of Washington State bill processing agency that disburses child support payments

to other states/intermediary is old and well known.” (11/3/2004 Final Office Action, pp. 3-4.)

However, as the Examiner has agreed in the reexamination proceedings, the Washington State reference does not disclose an accumulator agency, a bank, and a state that are separate entities, as recited by all of the independent claims as amended by this paper. For example, independent claims 371, 383, 396, 405, 440, and 456 recite a method by an accumulator agency of accumulating a child support payment through a bank and processing a child support disbursement to a governmental state entity of the United States, wherein the accumulator agency, the bank, and the state are separate entities. All of the other independent claims recite similar language.⁴

Regarding similar amendments in the reexamination proceedings, the reexamination Examiner stated that “[t]he Amendment submitted by the Applicant was sufficient to distinguish [the] claims...from the Washington State Reference.” (Reexamination Control No. 90/006,728, 8/1/05 Office Action, p. 4). A copy of that Office Action is attached as Exhibit A. Furthermore, a copy of the Office Action issued in the reexamination proceedings on March 23, 2005, in which all of the rejections based on the Washington State reference were withdrawn, is attached as Exhibit C.

⁴ The present application includes six independent method claims of differing scopes, i.e., claims 371, 383, 396, 405, 440, and 456. For each independent method claim, the application includes a corresponding independent claim directed to a system and, in some cases, a corresponding independent claim directed to a computer usable medium. In particular, claim 371 corresponds to claims 375 and 379, and their respective dependent claims; claim 383 corresponds to claims 389 and 395, and their respective dependent claims; and claim 396 corresponds to claims 400 and 404, and their respective dependent claims. Furthermore, claim 405 corresponds to claim 422 and its dependent claims; claim 440 corresponds to claim 448 and its dependent claims; and claim 456 corresponds to claim 470 and its dependent claims.

By this paper, as requested by the Examiner, Applicant has amended every independent claim to clarify that the accumulator agency is a separate entity from the state and the state's bank. Accordingly, as in the reexamination proceedings of the '107 patent and the '669 patent (i.e., the grandparent and greatgrandparent of the present application), the claims have been amended to recite an accumulator agency, a bank, and a state that are separate entities, distinguishing the claims from the Washington State reference. Therefore, as agreed by the Examiner in the November 10, 2005, telephone call, the rejections based on the Washington State reference, i.e., the section 103 rejections of claims 371-483, are overcome.

V. CONCLUSION


As requested by the Examiner and as agreed upon in the reexamination proceedings of the grandparent and greatgrandparent of the present application, Applicant has amended all of the independent claims to distinguish them over the Washington State reference and submitted all of the evidence used to show that the Remington patent is not prior art to the present claims. Accordingly, Applicant requests the reconsideration and withdrawal of the pending rejections of claims 371-483 and requests that the Examiner allow all of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 15, 2006

By: 
Erika H. Arner
Reg. No. 57,540

Attachments:

Exhibit A: 8/1/2005 Final Office Action, Reexamination Control No. 90/006,728

Exhibit B: Response to Final Office Action filed in Reexamination Control No.
90/006,728 on 9/29/2005, including Supplemental Declaration of John Polk under
37 C.F.R. § 1.131 and exhibits 69-72

Exhibit C: 3/23/2006 Office Action, Reexamination Control No. 90/006,728